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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,973	06/13/2008	Michel Banatre	017346-0192	8871
22428 7590 01/13/2010 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
DASS, HARISH T				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/585,973

Applicant(s)

BANATRE ET AL.

Examiner

HARISH T. DASS

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This final is in response to applicant's communication 12/16/2009.

The finality of last office action is withdrawn and this action is made final in response to applicant's filing of response to Non-Compliant.

The Non-Compliant is removed.

The status of the claims 1-24 remained rejected.

Priority: Jan 14, 2004.

Status of Claims:

Claims 1-24 are pending.

IDS: One of the IDS is not in English and it has not been considered (see below – response to argument).

Claim Rejections - 35 USC § 112 – This rejection is withdrawn based on the amendment to the claim.

Claim Objections

1. Claim 3 recites the limitation "the apparatus (32)" in line 2. There is insufficient antecedent basis for this limitation in the claim (USC 112 2nd paragraph). It is not clear

that "the apparatus (32)" refers the apparatus claimed in claim 1 line 3 or a different apparatus. Examiner assumes that "the apparatus (32)" refers to claim 1. Proper correction is required.

Examiner suggests it should be written "said apparatus" or "the apparatus".

Double Patenting

2. Claim 3 (added claim) is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 remain are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebetciouglu et al. (Sebetciouglu - US 5,719,918) in view of Jacobson (US 2003/0004876 A1).

Re. Claim 1, Sebetciouglu discloses

- a station capable of carrying out a transaction [Abstract; col. 3 lines 1-7, col. 6 lines 41-46]; and
- an **apparatus** capable of setting up a wireless communication network with one or more mobile terminals, based on a connection protocol, as well as a communication with the station [Figures 1-3, 10 (communication network and mobile terminal) and associated descriptions; col. 5 line 57 through col. 6 line 6 (cellular telephone network; protocols for interfacing SMSC to THS)];
- wherein the **connection protocol** is configured to allow the initial exchange of an identity information (IDS) transmitted by a mobile terminal present in the **zone in exchange for** a unique temporary code (IDT) (PIN), such **exchange** being followed by the launch of a background function allowing the preparation of at least part of a transaction on the basis of the identity information (IDS) [Abstract; Figures 2-6, 10, 12 and associated descriptions; col. 1 lines 9-60, col. 3 line 1 through col. 4 line 4 (cellular telephone Network, apparatus, unique code), col. 5 line 57 through col. 6 line 46, col. 15 line 28 through col. 16 line 54]; and
- wherein the station is capable, upon presentation of the unique temporary code (IDT), of recovering then completing as required and validating the transaction [col. 14 lines 56-59; col. 15 line 28 through col. 16 line 54];

Sebetciouglu does not explicitly

- wherein the apparatus is configured with a perimeter selected to cover a determined zone, close to the station.

Jacobson discloses

- wherein the apparatus is configured with a perimeter (radius) selected to **cover a determined zone, close to the station** [Abstract; Figures 4-5; paragraphs 100-101 - "small radius from the base station (e.g., a few tens of meters)." Paragraph 143 – "a short range radio communication protocol, such as Bluetooth and the like" for short distance]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art motivated to modify the disclosure of Sebetciouglu and include wherein the apparatus is configured with a perimeter selected to cover a determined zone, close to the station, as disclosed by Jacobson to provide high mobility long range cellular communication network services regardless of the point of attachment of the terminal to the network for communication between the terminals using short range radio protocols using standard wireless protocol with low interference at lower cost, low energy consumption which can share data and voice signal to transact.

Re. Claims 2-24, Sebetciouglu discloses

Claim 2

- wherein the station is configured to form part of a wireless communication network of the said apparatus;

Claim 6

- wherein the background function is launched upon receipt of a message or through the communication apparatus;

Claim 7

- wherein the background function is implanted at least in part in the station or in a local network of which the station forms part;

Claim 8

- wherein the background function is implanted at least in part in the apparatus.

Claim 9

- a communication unit capable of allowing a communication with a remote server, and in that the preparation of transaction comprises at least one verification linked to the said identity information (IDS), and carried out by interrogation of the remote server.

Claim 16

- wherein the presentation of the unique temporary code (IDT) to the station is carried out from the mobile terminal.

Claim 17

- wherein the station comprises a verification function capable of comparing the value of the unique temporary code (IDT) presented with a value of the reference unique temporary code (IDT) and whose result is a condition of validation of the transaction [see enter document particularly - Abstract; Figures 2-6, 10, 12 and associated descriptions; col. 1 lines 9-60, col. 3 line 1 through col. 4 line 4 (cellular telephone Network, apparatus, unique code), col. 5 line 57 through col. 6 line 46, col. 15 line 28 through col. 16 line 54].

Jacobson discloses the following limitations not disclosed by Sebetciouglu.

Art Unit: 3695

Jacobson discloses:

Claims 2, 4

- wherein the apparatus is configured to operate according to a short-range radio communication standard; characterized in that the apparatus is contrived (configured) to operate according to a short-range radio communication standard;

Claim 5

- wherein the apparatus is configured to operate according to the Bluetooth or NFC standard;

Claim 10

- the non-prepared part of the transaction comprises a financial element, and wherein the interrogation of the remote server comprises a credit verification linked to the identity information (IDS).

Claim 11

- the interrogation of the remote server comprises a credit verification for an amount linked at least in part to a class of transactions carried out by the station and to the identity information (IDS).

Claim 12

- the interrogation of the remote server comprises a credit verification for an amount defined by complementary data established during the initial exchange.

Claim 13

- wherein the transaction comprises a cash withdrawal.

Claim 14

- the transaction is a commercial transaction (inherent).

Claim 15

- the transaction is of the access control type (card controlled).

Claim 18

- the station further comprises an interrogation function configured to set up as the value of the reference unique temporary code (IDT) a value of the unique temporary code (IDT) recorded in a memory of the mobile terminal.

Claim 19

- the station comprises a capture element for presentation of the unique temporary code (IDT).

Claim 20

- the value of the reference unique temporary code (IDT) is transmitted by the mobile terminal.

claim 21

- wherein presentation of the unique temporary code (IDT) to the station is carried out from the mobile terminal through the same wireless communication network.

Claim 22

- a monitor function capable of cancelling a transaction prepared according to a selected expiry criterion (inherent in card authorization - card has expiry date).

Claim 23

- the apparatus is configured to operate according to a short range radio communication standard.

Claim 24

- wherein the interrogation of the remote server comprises a credit verification for an amount defined by complementary data established during the initial exchange [see entire document particularly - Abstract; Figures 4-5; paragraphs 02, 07-08,26, 100-101, 106,110, 121-129, 134,158].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Sebetcioğlu and include the above features, as disclosed by Jacobson, to provide a transaction system with wireless device and plurality of bases station using short message service center and mobile terminal for paying for the purchases of goods and service by credit card, where the user is authenticated by the mobile terminal according to the mobile terminal ID, and requesting a user secret code (PIN), from mobile terminal which uses low cost, low interference commercially available communication equipment.

Response to Arguments

4. Applicant's arguments filed 8/3/2009 have been fully considered but they are not persuasive. The examiner has rewritten the office action to clearly show that the prior arts of record (Sebetcioğlu et al. in view of Jacobson) in combination disclose all of the limitations claimed, with there broadest reasonable interpretation in light of specification, limitations from the specification are not read into the claims (See *In re Van Geuns*).

In response to applicant's argument that (page 6 – IDS) "The Office states ... IDS is not in English ... a copy of ISR was attached to the IDS..." Examiner has not identified the ISR as argued in the remarks.

(B) All content requirements of 37 CFR 1.98. See MPEP § 609.04(a) for more information.

(3) For non-English documents that are cited, the following must be provided:

(a) A concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, unless a complete translation is provided; and /or

(b) A written English language translation of a non-English language document, or portion thereof, if it is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c). After the examiner reviews the IDS for compliance with 37 CFR 1.97 and 1.98, the examiner should: (See MPEP § 609.05).

(A) Consider the information properly submitted in an IDS in the same manner that the examiner considers other documents in Office search files while conducting a search of the prior art in a proper field of search.

Examiner will consider the missing IDS document after Applicant identifies the ISR. Examiner called the attorney and left a message in this regard 11/9/09.

In response to applicant's argument that secondary reference (Jacobson), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that secondary reference (Jacobson) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the system disclosed by Jacobson covers zone closed to the station. 1) **Applicant does not claim the range of perimeter, what is the limitation (operation boundary) to be closed to the station, since "closed to the station" is indefinite,** 2) selected to cover a determined zone, close to the station is non-functional it is for intended use. For example, a cellular phone with high power rating operating closed to the tower 100 meters radius (boundary or perimeter limit) is very closed, Similarly, an apparatus with low power Bluetooth technology 100 meters may be out of bound but it may be configured to be used inside a room is inbound of the power limit. FM radio stations in US are around 20 miles radius. Applicant's argument is not persuasive.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kyle Charles can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Primary Examiner, Art Unit 3695

1/7/2010